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IN THE

Supreme Court of the United States

OCTOBER TERM, 1941

No. 965

GENZO SHIMADZU and NORTHEASTERN ENGINEERING CORPORATION,
Petitioners,

v.

THE ELECTRIC STORAGE BATTERY CO.,
Respondent.

PETITION FOR A WRIT OF CERTIORARI AND BRIEF IN SUPPORT THEREOF

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TABLE OF CONTENTS

	PAGE
Petition for a Writ of Certiorari	1
Jurisdiction	2
Statutes Involved	2
Previous Decisions Herein	2
Statement	3
Patents Involved	4
The U. S. '149 Patent	4
The Foreign Patents Involved Under R. S. 4887	4
Previous Proceedings Herein	5
Previous Petition and Brief of Defendant for Certiorari and Brief on Argument	6
Proceedings After Remand	9
Effect of the Decisions Below on the Question of Whether U. S. '150 Is Now Invalidated by Prior Public Use	12
Questions Presented	13
Reasons Relied Upon for Allowance of the Writ	15
Brief in Support of Petition	19
Statement	19
Specifications of Error	19
Argument	22
POINT I—In holding invalid U. S. Patent 1,584,149 under R. S. 4887 by reason of the patenting of the invention thereof in a foreign country on an application filed more than twelve months prior to the filing of the application for the aforesaid U. S. Patent, the Circuit Court of Appeals decided a question previously set at rest to the contrary by this Court and thus so far departed from the accepted and usual course of judicial proceedings as to call for the exercise of this Court's power of supervision	22

32612

PAGE

POINT II—In allowing the defendant to prevail on a defense, the establishment of which required defendant to repudiate representations which it made to this Court and upon which it relied in seeking a review of the case by this Court by petition for writ of certiorari and in presenting the case on argument, the Circuit Court of Appeals so far departed from the accepted and usual course of judicial proceedings as to call for the exercise of this Court's power of supervision..... 25

POINT III—Where a party urging foreign patents as a bar to a U. S. patent under R. S. 4887 maintains, in proceedings below after remand that the processes of such patents are different from that ultimately found concurrently by the Courts below to be covered by the U. S. patent, the Circuit Court of Appeals, in sustaining said defense notwithstanding, has decided an important question of Federal law in a manner probably in conflict with the applicable decision of this Court and of other Circuit Courts of Appeals..... 28

POINT IV—Where a foreign patent urged as a defense under R. S. 4887 has been held by the Circuit Court of Appeals to claim alternatively in the same claims two inconsistent processes, one of which is operable and the other inoperable, and that Court has disregarded the inoperable process and the inconsistency of the entire document and held that the operable process constitutes the invention of the foreign patent for the purpose of invalidating an otherwise meritorious U. S. patent, the court below has decided an important question of Federal law probably in conflict with applicable decisions of other Circuit Courts of Appeals, which has not been but should be settled by this Court..... 30

PAGE

POINT V—Where it has been established on the record that Shimadzu was a pioneer inventor of the process of U. S. '149, thereby negativing the existence of prior art in respect thereof, in holding that claim 1 thereof is invalid in view of prior art without particularizing as to which prior art was considered to be of invalidating effect, the Court of Appeals decided an important question of Federal law which has not been but should be decided by this Court 33

POINT VI—Where one patent is held invalid by this Court solely by reason of prior public use and the bill is dismissed as to it pursuant to this Court's mandate, but another patent to the same inventor applied for earlier, applications for both of which patents were copending in the U. S. Patent Office, is remanded to the courts below for further proceedings and, upon such proceedings, the remanded patent is concurrently held by the courts below to disclose the same invention as the invalidated patent, and it manifestly appears that, under the applicable decisions of this Court, the claims in the invalidated patent which read on the disclosure of the remanded patent are entitled to the benefit of the earlier filing date of the application for the remanded patent, and said remanded patent is not subject to the prior public use bar, the sole ground upon which this Court invalidated the later filed patent, but the courts below have no jurisdiction under the aforesaid mandate to apply the law established by this Court and plaintiffs likewise cannot there seek remedy, there arises a novel question of Federal law, apparently without precedent, which has not been but should be reviewed and settled by this Court in order to do complete equity and to avoid confusion..... 35

Conclusion 38

Appendix *1*

Table of Cases Cited

PAGES

Alabama Power Co. v. *Ickes*, 302 U. S. 464..... 22
American Tri-Ergon Corp. v. *Paramount Publix*, 71 F. (2d) 153 (2 C. C. A.).....29, 33
Atlantic, Gulf & Pacific Co. v. *Wood*, 288 Fed. 148 (5 C. C. A.)..... 32

Chatman et al. v. *Wintroath*, 252 U. S. 126, 137..... 36
Cimiotti Unhairing Co. v. *Comstock Unhairing Co.*, 115 Fed. 524 (C. C. S. D. N. Y. 3)..... 32

Davis v. *Cornwall*, 68 Fed. 522, 524 (2 C. C A.)..... 27
Davis v. *Milburn*, 1 F. (2d) 227 (2 C. C. A.)..... 29
Davis v. *Wakelee*, 156 U. S. 680, 689..... 27

Edison v. *Allis-Chalmers Co., et al.*, 191 F. 837, 843.... 37

General Electric Co. v. *Independent Lamp & Wire Co., Inc.*, 267 F. 824, 836..... 37
General Talking Pictures Corp. v. *Western Electric Co.*, 304 U. S. 175, 178..... 22
Godfrey v. *Eames*, 1 Wallace 317..... 37

Hayes-Young Tie Plate Co. v. *St. Louis Transit Co.*, 137 F. 80, 82 (C. C. A. 8)..... 37
Hennebique Const. Co. v. *Myers*, 172 Fed. 869 (3 C. C. A.) 32
Hillard v. *Fisher Book Typewriter Co.*, 159 Fed. 439 (2 C. C. A.)..... 32

Illinois v. *Ill. Central R. R. Co.*, 184 U. S. 77..... 25
In re Sanford Tool Co., 160 U. S. 247..... 22

Kintner v. *Atlantic Communication Co.*, 240 Fed. 716, 720, 721 (2 C. C. A.).....27, 32

Leads & Catlin Co. v. *Victor Talking Machine Co.*, 213 U. S. 301 33

Michaels v. *Olmsted*, 157 U. S. 198..... 27

PAGES

Novadel Process Corp. v. *J. P. Meyer & Co.*, 35 F. (2d) 697 (C. C. A. 2) 37

Officer v. *J. L. Owens Co.*, 252 Fed. 337 (8 C. C. A.) 27

Phila., Wilmington & Baltimore R. R. Co. v. *Howard*, 13 How. 307, 337 27

Sibbald v. *United States*, 12 Peters 488 25
Singer v. *Braunsdorf*, 7 Blatchf. 521, Fed. Case No. 12,897 37
Smith v. *Boston Elev. Ry. Co.*, 184 Fed. 387, 389, 390 (1 C. C. A.) 27
Smith v. *Goodyear Dental Vulcanite Co., et al.*, 93 U. S. 486, 501 37
Sorensen v. *Pyrate Corp.*, 65 F. (2d) 982 25
Stead Lens Co. v. *Kryptok Co.*, 214 Fed. 368 (8 C. C. A.) 29, 32

Westinghouse v. *Stanley*, 138 Fed. 823 (1 C. C. A) 29

Other Authorities Cited

Judicial Code, Section 240(a) as amended by the Act of February 13, 1925 (28 U. S. C. A. Section 347(a) .. 2

Rules of Supreme Court of the United States, General Rule 38, Section 5, subdivision (b) 2

Revised Statute 4886 (35 U. S. C. A. 31) 2

Revised Statute 4887 (35 U. S. C. A. 32) 2, 5, 14, 15, 16, 22, 23, 24, 28, 30, 31, 32

Trading with the Enemy Act, U. S. C. Title 50, Section 10, subdivision (g) 3

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OCTOBER TERM, 1941

No.

GENZO SHIMADZU and NORTHEASTERN ENGINEERING CORPORATION,
Petitioners,

v.

THE ELECTRIC STORAGE BATTERY CO.,
Respondent.

PETITION FOR A WRIT OF CERTIORARI

To the Honorable the Chief Justice of the United States and the Associate Justices of the Supreme Court of the United States:

Petitioners Genzo Shimadzu and Northeastern Engineering Corporation (hereinafter referred to as "plaintiffs" for the sake of clarity) respectively pray that a writ of certiorari issue to the United States Circuit Court of Appeals, Third Circuit, to review a judgment of that court filed on November 19, 1941 (rehearing denied January 5, 1942) reversing the decree and judgment of the United States District Court for the Eastern District of Pennsylvania (KIRKPATRICK, *J.*) entered after remand by this Court of this cause, No. 441, October Term, 1938.

Jurisdiction

The jurisdiction of this Court is invoked under Section 240 (a) of the Judicial Code as amended by the Act of February 13, 1925 (28 U. S. C. Section 347 (a)) and under General Rule 38 of this Court, Section 5, subdivision (b).

Statutes Involved

The statutes involved are Revised Statutes 4886 and 4887 (35 U. S. C. 31 and 32 respectively) found in the appendix attached hereto (Appendix, pp. 1, 2).

Previous Decisions Herein

Original Opinion of the District Court (printed at R. II, 1162, reported in 17 F. Supp., 42).

Supplemental Opinion of the District Court (not included in Record, reported in 36 U. S. P. Q. 25).

Opinion of Circuit Court of Appeals on first appeal (printed at R. IV, 1272; reported in 98 F. (2d) 831).

Opinion of this Court on previous certiorari (printed at R. IV, 1279; reported 307 U. S., 5).

Opinion of the District Court on scope of mandate (not included in Record; reported in 30 F. Supp., 865).

Opinion of District Court on remand from this Court (printed at R. IV, 1298; reported 35 F. Supp., 745).

Opinion of Circuit Court of Appeals on second appeal (printed R. IV, 1467; reported 123 F. (2d) 890).

Statement

This is an infringement suit in equity for an injunction and an accounting upon six United States patents granted to Genzo Shimadzu. Only one, United States Patent 1,584,149 (hereinafter referred to as U. S. '149) relating to a process of manufacturing fine powder from pieces of metallic lead, issued May 11, 1926, on an application filed January 30, 1922, was remanded by this Court for further proceedings.

The parties plaintiff are Genzo Shimadzu, as patentee and owner of said patent, and Northeastern Engineering Corporation, a Delaware corporation, as exclusive licensee thereunder. Shimadzu is a manufacturer of storage batteries in Japan. Northeastern Engineering Corporation, which is wholly American owned (hereinafter referred to as "Northeastern") is engaged in the business of granting sub-licenses to manufacturers of storage batteries in the United States and Canada under certain Shimadzu patents including the aforesaid U. S. Patent 1,584,149.

The Trading with the Enemy Act, Title 50 U. S. C., Section 10, subdivision (g), found in the appendix (Appendix, p. 5), provides that any enemy may prosecute suits in equity against any person other than a licensee thereunder to enjoin infringement of letters patent in the United States.

The respondent herein is The Electric Storage Battery Co. (hereinafter referred to as "defendant" for the sake of clarity), a manufacturer of storage batteries in Philadelphia, Pa., and having a wholly owned subsidiary engaged in the manufacture of storage batteries elsewhere in the United States.

Patents Involved

The U. S. '149 Patent

U. S. '149 discloses and claims a "meritorious invention" relating to the manufacture in commercial quantities of fine powder from pieces of lead in a dry state by rumbling the lead pieces in a rotating mill, blowing a blast of air into the mill, forming the powder by attrition, and blowing it out by the air blast.

It issued May 11, 1926, on an application filed January 30, 1922.

The Foreign Patents Involved Under R. S. 4887

Japanese patent 41,728 (hereinafter referred to as "Japanese '728" for brevity) relates to a method of grinding lead to lead powder by placing pieces of lead in a closed rotating vessel. The use of air is not involved. It is a batch process.

It was issued to Shimadzu February 13, 1922, on an application filed November 21, 1920, in Japan.

Japanese patent 42,563 (hereinafter referred to as "Japanese '563" for brevity) is an addition to Japanese '728, in that it includes the additional step of removing powder from the mill by means of the use of a current of air or other inert gas such as nitrogen.

It was issued to Shimadzu May 10, 1922, on an application filed November 27, 1920, in Japan.

Both sides agree that the processes of both these Japanese patents are substantially inoperable and that neither involves the oxidation or temperature control present in the process of U. S. '149 (Appendix, pp. 5, 6).

The claims of all three above patents are found in the appendix (Appendix, pp. 2-4).

Previous Proceedings Herein

By its first decree of December 14, 1936, the United States District Court for the Eastern District of Pennsylvania (KIRKPATRICK, *J.*) adjudged claims 1 and 2 of U. S. '149, claims 1-4, 6, 8-13 of U. S. Patent 1,584,150 (hereinafter referred to as U. S. '150) and claims 10 and 11 of U. S. Patent 1,896,020 (hereinafter referred to as U. S. '020) to be valid and infringed, and the remaining claims in issue valid but not infringed (R. II, 1192).

Both parties appealed to the Circuit Court of Appeals for the Third Circuit, which affirmed the decree of the District Court on its opinion (R. II, 1220c).

Defendant petitioned for rehearing, which was denied (R. II, 1220ii), and then petitioned this Court for writ of certiorari (No. 441, October Term, 1938) advancing three reasons for allowance of the writ.* Certiorari was granted (305 U. S. 591).

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* Defendant's petition (p. 7) stated such reasons as follows:

"(1) In holding that in the ascertainment, under the Patent Statutes of the United States, of the date of an invention made abroad, such Statutes do not proscribe all evidence of invention abroad other than that derived from patents, printed publications, or patent applications within the terms of R. S. 4887, the Court below has decided an important question of federal law which has not been, but should be, settled by this Court.

(2) In holding that United States patents are not invalidated by commercial use by others in this country, of the inventions patented, for more than two years before the actual filing of the applications for such patents, the Court below has decided a federal question in a way probably in conflict with applicable decisions of this Court, as well as of another Circuit Court of Appeals.

(3) In holding valid a United States patent granted to one who had made an invention in a foreign country, but who withheld and suppressed it for a long period of time and did not file an application for a United States patent therefor until more than two years after the thing subsequently patented had been brought into commercial use by others in this country, the Court below decided an important question of federal law in a way probably in conflict with an applicable decision of this Court."

Previous Petition and Brief of Defendant for Certiorari and Brief on Argument

Defendant (then petitioner) in its petition to this Court for certiorari in No. 441, October Term, 1938, stated (p. 3):

> *"The Courts below found that he* (Shimadzu) *had no foreign patent equivalent to his patent No. 1,548,149."**

In neither its specifications of error in its brief supporting its petition nor in its brief on the argument did defendant specify error in respect of the concurrent findings of the lower courts that the patents in suit were not invalid by reason of the filing of an application therefor in a foreign country more than one year before the filing of the application in this country (Defendant's Brief Supporting Petition, pp. 10-12; Brief on the Argument, pp. 9, 10).

At page 14 of the brief supporting its petition, defendant stated:

> "Shimadzu's inventions were made in Japan. In June 1921 his inventions had not been described in any printed publication anywhere. *No application for patent therefor has been filed in any country.*"

After certiorari was granted defendant (then petitioner) stated to this Court in its brief on argument (p. 4):

> "The questions here presented arise from facts not disputed and from concurrent findings of fact of both Courts below."

* Italics and parenthetical expressions throughout petition and brief are ours unless otherwise indicated.

In support of Point II of its brief on argument that Shimadzu had concealed and withheld his invention, it stated:

> "The Courts below found that the invention of patent 1,584,150 was made in Japan in August, 1919 (R. II, 1166). It is clear that the Courts below intended this date to apply to the inventions of patents 1,584,149 and 1,896,020, as well (R. II, 1188)" (Defendant's Brief on Argument, p. 28).

> "As Shimadzu was filing applications for patents in Japan and elsewhere after August, 1919, *but delayed filing any application anywhere for the inventions of the patents here in suit* until long after the same or like inventions had gone into commercial use in this country, it would seem manifest under the foregoing authorities *that the inventions of the patents in suit and each of them* must be deemed to have been concealed, suppressed or abandoned and that those patents must therefore be adjudged invalid" (Defendant's Brief on Argument, p. 31).

Defendant therefore accepted the concurrent findings of the Courts below that no application for the invention of U. S. '149 had been filed in Japan until long after defendant's commercial production began in June, 1921, only about seven months before January 30, 1922, the application date of U. S. '149. Defendant thus admitted that no foreign patent corresponding to U. S. '149 was applied for more than 12 months prior to the filing of the application for U. S. '149, and urged that fact before this Court in support of its contention that Shimadzu abandoned the invention of U. S. '149.

This Court in its opinion herein took the defendant at its word, stating:

> "No controversy of fact is involved as the petitioner concedes it must accept the concurrent findings of the courts below" (307 U. S. 5, 9; R. IV, 1280).

One of the concurrent findings was that none of the patents including U. S. '149 was invalid under R. S. 4887 because of the filing of an application for the invention in Japan more than a year before the filing of one here.

This Court, holding U. S. '150 and U. S. '020 to be invalid solely on the grounds of prior public use, reversed the decree of the Circuit Court of Appeals and remanded the case to the District Court

> "* * * with directions to dismiss the bill as to Nos. 1,584,150 and 1,896,020, and to proceed, in the light of the dismissal as to those patents, to determine whether 1,584,149 is valid and infringed" (307 U. S. 5, 22; R. IV, 1292).

Referring to the original opinion of the District Court indicating a possible doubt as to the validity of U. S. '149 in view of the prior art, this Court stated:

> "In view of our decision as to 1,584,150 *and of the basis of the decision below,* respecting 1,584,149, we think the petitioner is entitled to a re-examination of the questions of validity and infringement of the latter" (307 U. S. 5, 22; R. IV, 1291).

It is evident from this Court's opinion that re-examination of the validity of U. S. '149 was directed to the effect thereon of the prior art and did not involve the question of whether U. S. '149 is invalid under R. S. 4887 by reason of any foreign patent.

Neither of the Japanese patents 41,728 and 42,563 are prior art as against U. S. '149.

Proceedings After Remand

Upon the rehearing after remand as to U. S. '149 no new evidence was presented.

The District Court held:

> "Both sides agree that, if '149 is for a patentable process, it is substantially the process disclosed by '150. * * *
>
> Claim 2 may be taken as typical of the process claims of '150. * * *
>
> The process (as distinguished from the principle) of claim 2 of the '149 patent is (1) putting pieces of lead into a rotatable vessel, (2) rotating the vessel at a low speed, (3) forcing an air blast into and through the vessel, (4) permitting the lead masses to be reduced to powder by surface attrition, and (5) carrying the powder out of the vessel with the air" (R. IV, 1299, 1300; 35 F. Supp. 745, 746, 747) [parentheses not ours].

It held that oxidation was inherent in U. S. '149; that defendant's contentions that U. S. '149 was no advance over Japanese '563 and that the opinion of this Court excluded oxidation from the claims of U. S. '149 were untenable (R. IV, 1301-1303; 35 F. Supp. 747); that as U. S. '149 did not eliminate heat or forbid oxidation it could not be said that the process was the same as Japanese patents '728 or '563; and said:

> "I am convinced that '563 must be read as a disclosure of the use of an inert or inactive medium which will not oxidize lead, and as nothing more. * * * It was demonstrated that, in an inert medium, the balls simply polish one another and no powder will be produced; so even if the claim could be construed by omitting the word 'other' and read, 'air

> or an inactive gas,' as though they were alternatives, it would be wholly invalid because it would then suggest two inconsistent and mutually exclusive methods, one of which might lead to a useful result and the other of which would lead to nothing. A patent, like any other instrument, may be of doubtful meaning, or it may contain several meanings applicable to varying conditions, but it may not have two meanings inconsistent with each other." (R. IV, 1304; 35 F. Supp. 748).

It then held that the invention defined in claim 2 of U. S. '149 is substantially the same as that of U. S. '150; that the prior art does not invalidate claim 2 of U. S. '149; and that claim 2 is valid and infringed (R. IV, 1306, 1308; 35 F. Supp. 749, 750).

It held claim 1 of U. S. '149 invalid by reason of the prior art (R. IV, 1308; 35 F. Supp. 750).

Both sides appealed to the United States Circuit Court of Appeals for the Third Circuit, which held claim 1 invalid on the prior art, and by a divided court claim 2 invalid because of its substantial identity with Japanese '563 and because application for U. S. '149 had not been filed within a year of the filing of the application for Japanese '563, as required by R. S. 4887 (35 U. S. C. 32).

It held, however, that if claim 2 is valid, the defendant has infringed it.

Speaking of U. S. '149, it said:

> "We think that despite this apparent lack of knowledge as to why his process worked, the disclosures of '149 considered in the light of the prior art (disregarding the Japanese patents) *constituted invention of a high order.* Shimadzu discloses a new and commercially useful method for making the fine metallic powder for batteries. *There were no com-*

> *parable disclosures in the art in the United States.* By blowing air into the cylinder Shimadzu revolutionized the art of making fine lead powder" (R. IV, 1476; 123 F. (2d) 896) [parentheses not ours].

It agreed with the District Court *"that '149 discloses an operable process, the same invention claimed in '150";* but held, *contrary to the statements made by both parties in both lower courts,* that an operator skilled in the art would obtain similar results by following the teachings of Japanese '563; that *"In fact in '563 the inventor has claimed two processes: one, operable to produce substantial quantities of lead powder; the other, inoperable to that end"; and that the operable process must be held to constitute the invention;* that if Japanese '563 had been issued in this country, "we think that Shimadzu would have been entitled to a monopoly in the field" (R. IV, 1479; 123 F. (2d) 897).

GOODRICH, *J.,* in his dissenting opinion did not see why it follows that if Japanese '563 discloses two processes, one skilled in the art would choose the operable one; that with equal plausibility it could be argued that he would choose the inoperable one in the belief that it was safer, doubting that air would be inactive under the circumstances but feeling that nitrogen surely would; that Shimadzu had not got down to the substance of his invention in Japanese '563 and that Japanese '563 and U. S. '149 are not substantially identical; "that Shimadzu would have had a bad time if the American patent had been issued in the terms of '563" and "If he could not have upheld it then, it seems to me that it should not stand in his way now" (R. IV, 1482; 123 F. (2d) 899).

Claim 1 of U. S. '149 was held to be "invalid by reason of the prior art" by the District Court (R. IV, 1308; 35

F. Supp. 745, 750), although the record shows that Shimadzu was a pioneer inventor of the process of U. S. '149. This holding was concurred in by the Circuit Court of Appeals. Neither Court specified what prior art it considered to be of invalidating effect, although the Circuit Court of Appeals held it to be "for substantially the same process as that claimed in the claims of (Japanese) '728" (R. IV, 1480; 123 F. (2d) 897) application for which was filed after August, 1919, the date of invention of the process of U. S. '149.

Effect of the Decisions Below on the Question of Whether U. S. '150 Is Now Invalidated By Prior Public Use.

As a result of its previous consideration of this case, this Court held the claims in issue of U. S. '150 to be invalid by reason of defendant's public use of the process thereof which commenced during June, 1921, more than two years prior to July 14, 1923, the filing date of the application for U. S. '150.

Application for U. S. '149 was filed January 30, 1922, well within the two-year period commencing June, 1921. Accordingly, this Court held that "The defense of prior public use is not made out against patent 1,584,149, for which application was filed January 30, 1922" (R. IV, 1290; 307 U. S. 20, 21).

The District Court and the Circuit Court of Appeals in the proceedings after remand have concurrently held that U. S. '149 and U. S. '150, *applications for which were copending, disclose the same invention.*

Plaintiffs, therefore, find themselves in this incongruous position: U. S. '150 has been held invalid by this Court on

the ground of prior public use and, pursuant to its mandate, the bill has been dismissed as to this patent. On remand, U. S. '150 and U. S. '149 have now been held concurrently below to disclose the same invention. U. S. '150 contains a group of claims found in Appendix (pp. 3, 4) which read upon the disclosure of U. S. '149. Under the applicable decisions of this Court and the foregoing facts those claims are entitled to the earlier filing date of U. S. '149 for the purpose of overcoming the defense of prior public use. However, because of the mandate of this Court, plaintiffs are unable to obtain relief from their position, now clearly revealed to be inequitable, except from this Court.

Questions Presented

(1) In holding invalid U. S. Letters Patent 1,584,149 by reason of the patenting of the invention thereof in Japanese Patents 41,728 and 42,563, applications for which were filed more than twelve months prior to the filing of the application for the aforesaid U. S. Patent, has not the Circuit Court of Appeals decided a question previously set at rest by this Court in a manner contrary to this Court's decision and mandate and thus departed from the accepted and usual course of judicial proceedings?

(2) Where defendant, in urging Japanese Patents 41,728 and 42,563 as a defense under R. S. 4887 against U. S. Letters Patent 1,584,149, has maintained before both lower courts, in the proceedings after remand, that the processes thereof are different from that now concurrently found by the lower courts to be covered by U. S. Letters Patent 1,584,149, did not the Circuit Court of Appeals, in sustaining said defense, decide an important question of federal law in a manner probably in conflict with the ap-

plicable decisions of this Court and of other Circuit Courts of Appeals?

(3) In considering the effect of foreign patents urged as a defense under R. S. 4887, may the court below disregard the teachings of the foreign patents which expressly limit the processes of the foreign patents to one completely different from that disclosed and claimed in a U. S. Patent against which the foreign patents are being urged?

(4) If a foreign patent urged as a defense under R. S. 4887 is held to claim alternatively *in the same claims* two inconsistent processes, one of which might be operable and the other of which is inoperable, may the inoperable process be completely disregarded and the operable process said to be the invention of the foreign patent, for the purpose of invalidating an otherwise meritorious U. S. Patent?

(5) Was not defendant, in effect, estopped from urging after remand that Japanese Patents 41,728 and 42,563 are for the same invention as U. S. Letters Patent 1,584,149 and, therefore, a bar to the latter under R. S. 4887, for the reason that it previously represented to this Court in support of one reason for granting its petition for writ of certiorari and again on the argument of the case before this Court, that Shimadzu filed no applications anywhere for the inventions of his U. S. Patents in suit from the day he made his inventions until he filed his U. S. applications therefor?

(6) Where one patent is held invalid by this Court by reason of prior public use and the bill is dismissed as to it pursuant to this Court's mandate, but another patent to the same inventor applied for earlier, *applications for*

both of which patents were copending in the U. S. Patent Office, is remanded to the courts below for further proceedings and, upon such proceedings, the remanded patent is concurrently held by the courts below to disclose the same invention as the invalidated patent, are not the claims in the invalidated patent which read on the disclosure of the remanded patent entitled to the benefit of the earlier filing date of the application for the remanded patent, for the purpose of overcoming the defense of prior public use, the sole ground upon which this Court invalidated the later filed patent?

(7) Where it has been established on the record that Shimadzu was a pioneer inventor of the process of the patent in suit, can there be any "prior art" in respect thereof?

Reasons Relied Upon for Allowance of the Writ

The discretionary power of this Court to grant the writ of certiorari is invoked upon the following grounds:

I

In holding U. S. patent 1,584,149 to be invalid under R. S. 4887 by reason of the patenting of the invention thereof in a foreign country on an application filed more than twelve months prior to the filing of the application for the aforesaid U. S. patent, the Circuit Court of Appeals decided a question previously set at rest to the contrary by this Court and thus so far departed from the accepted and usual course of judicial proceedings as to call for the exercise of this Court's power of supervision.

II

In allowing the defendant to prevail on a defense, the establishment of which required defendant to repudiate representations which it made to this Court and upon which it relied in seeking a review of the case by this Court by petition for writ of certiorari and in presenting the case on argument, the Circuit Court of Appeals so far departed from the accepted and usual course of judicial proceedings as to call for the exercise of this Court's power of supervision.

III

Where a party urging foreign patents as a bar to a U. S. patent under R. S. 4887 maintains, in proceedings below after remand that the processes of such patents are different from that ultimately found concurrently by the courts below to be covered by the U. S. patent, the Circuit Court of Appeals, in sustaining said defense notwithstanding, has decided an important question of Federal law in a manner probably in conflict with the applicable decisions of this Court and of other Circuit Courts of Appeals.

IV

Where a foreign patent urged as a defense under R. S. 4887 has been held by the Circuit Court of Appeals to claim alternatively *in the same claims* two inconsistent processes, one of which is operable and the other inoperable and that Court has disregarded the inoperable process and the inconsistency of the entire document and held that the operable process constitutes the invention of the foreign patent for the purpose of invalidating an otherwise meritorious U. S. patent, the court below has decided an important question of Federal law probably in conflict with applicable decisions of

other Circuit Courts of Appeals, which has not been but should be settled by this Court.

V

Where it has been established on the record that Shimadzu was a pioneer inventor of the process of U. S. '149, thereby negativing the existence of prior art in respect thereof, in holding that claim 1 thereof is invalid in view of prior art without particularizing as to which prior art was considered to be of invalidating effect, the Circuit Court of Appeals decided an important question of Federal law which has not been but should be decided by this Court.

VI

Where one patent is held invalid by this Court solely by reason of prior public use and the bill is dismissed as to it pursuant to this Court's mandate, but another patent to the same inventor applied for earlier, *applications for both of which patents were copending in the U. S. Patent Office,* is remanded to the courts below for further proceedings and, upon such proceedings, the remanded patent is concurrently held by the courts below to disclose the same invention as the invalidated patent, and it manifestly appears that, under the applicable decisions of this Court, the claims in the invalidated patent which read on the disclosure of the remanded patent are entitled to the benefit of the earlier filing date of the application for the remanded patent, and said remanded patent is not subject to the prior public use bar, the sole ground upon which this Court invalidated the later filed patent, but the courts below have no jurisdiction under the aforesaid mandate to apply the law established by this Court and plaintiffs likewise cannot there seek remedy, there arises a novel question of

Federal law, apparently without precedent, which has not been but should be reviewed and settled by this Court in order to do complete equity and to avoid confusion.

WHEREFORE your petitioners respectfully pray that a writ of certiorari be issued out of and under the seal of this Court directed to the United States Circuit Court of Appeals for the Third Circuit commanding said Court to certify and send to this Court on a day to be designated a full transcript of the record of all proceedings of the said Circuit Court of Appeals in this cause to the end that this case may be reviewed and determined by this Court; that the judgments and orders of the said Circuit Court of Appeals for said Circuit be reversed and that petitioners be granted such other and further relief as to this Honorable Court may seem just and proper.

GENZO SHIMADZU and NORTHEASTERN ENGINEERING CORPORATION,
Petitioners.

by GEO. WHITEFIELD BETTS, JR.,
GEORGE H. SOUTHER,
GEORGE YAMAOKA,
Counsel for Petitioners.